

REMARKS

The rejections under 35 U.S.C. § 103(a) of Claims 1-3 and 5-12 as obvious over U.S. 2003/0232555 (Nobuto et al) in view of U.S. 6,733,859 (Yoneda et al) and further in view of U.S. 6,838,172 (Yoon et al), and of Claim 4 over Nobuto et al in view of Yoneda et al and Yoon et al, and further in view of U.S. 5,969,015 (Zinke et al), are all respectfully traversed.

All of the above rejections depend on Nobuto et al. Applicants' assignee represents that under a contract of employment, the claimed invention was subject to an obligation of assignment to Kuraray, the assignee of Nobuto et al, at the time the presently-claimed invention was made. Thus, Nobuto et al, otherwise available only under 35 U.S.C. § 102(e), is disqualified as prior art pursuant to 35 U.S.C. § 103(c). Neither Yoneda et al and Yoon et al alone, nor combined with Zinke et al, disclose or suggest the presently-claimed invention. Accordingly, it is respectfully requested that the rejections over prior art be withdrawn.

The rejection of Claim 1 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

The rejection of Claims 5, 6 and 8 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. The Examiner finds that the rejected claims "recite physical properties, but fail to set forth what provides for such properties," citing *Ex part Slob*, 157 USPQ 172 (BdPatApp&Int 1968).

In reply, *Slob* involved an issue with respect to the expression "a liquefiable substance having a liquefaction temperature from about 40°C, to about 300°C, and being compatible with the ingredients in the powdered detergent composition." The Board found that the above-quoted term "purports to cover everything which will perform the desired functions regardless of its composition and, in effect, recites the compounds by what it is desired that

they do rather than what they are.” Applicants respectfully submit that the present situation distinguishes over *Slob*, as now discussed.

First of all, the rejection would appear to be moot with regard to Claim 5 in view of the above-discussed amendment. Nevertheless, even in the absence of the above-discussed amendment to Claim 5, there is nothing indefinite about this claim or non-amended Claims 6 and 8. Claims 6 and 8 require that the elastomeric polymer A, and the surface of the suede artificial leather, respectively, have a particular color fastness to light when measured by a particular method, as recited therein. Thus, if an elastomeric polymer, or a surface, does not satisfy the color fastness requirement of the respective claim, it is excluded therefrom; if it does satisfy the color fastness requirement, it is included within the terms of the claim. Thus, there can be no question of indefiniteness, since the method is described in the specification, i.e., beginning at page 31, line 21, and is in accordance with a public standard, i.e., JIS L0804. See the specification at page 31, lines 21-26. In addition, the examples and comparative examples in the specification were evaluated in this manner, as described in the specification at page 47, line 11 ff, and especially lines 23-29.

This can be contrasted to the “liquefiable substance” of *Slob*, which was bounded by a definite temperature range but an indefinite property of being “compatible.”

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

All of the presently active claims in this application are now believed to be in immediate condition for allowance. The Examiner is respectfully requested to rejoin the non-

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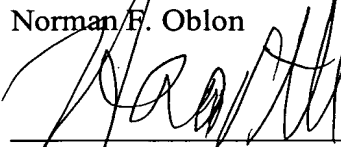
elected method claims, and in the absence of further grounds of rejection, pass this application to issue with all pending claims.

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

A handwritten signature in black ink, appearing to read 'Harris A. Pitlick', is written over a horizontal line.

Harris A. Pitlick  
Registration No. 38,779

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